

REMARKS (37 CFR 1.111)

Applicant has considered all points made by the Examiner in the Office Action and has incorporated Examiner's suggestions to ensure compliance with the applicable rules.

Applicant amended the claims to clarify the structure that Applicant believes distinguishes the present invention over the cited references, to clarify the function of the claimed invention, and to clarify the limitations within the claims drawn to such a structure. However, such amendments have not been made to narrow the claims of the original application, but rather simply to clarify claims due to grammar that the Examiner found unclear.

The examiner has indicated that Claims 3, 4, 7, 8, 13, and 14 would be allowable if amended to overcome the 35 U.S.C. §102 rejections and to include all limitations of the base claim and any intervening claim(s). Inasmuch as these claims have been amended accordingly, it is respectfully submitted that Claims 3, 4, 7, 8, 13, and 14 are now in a condition for allowance.

1. Claim Objections

The Examiner has objected to Claim 5 due to a typographical error in the claim. Specifically, Claim 5 included a duplication of the phrase "to said pagination program" at line 9. The duplication was a typographical error. Applicant has amended Claim 5 by deleting the duplicative "to said pagination program," such that the above-referenced typographical error is no longer included in Claim 5.

2. 35 U.S.C. §112 Rejection

The Examiner has rejected Claim 15 pursuant to 35 U.S.C. §112 on the basis that it contains the trademark/trade names FILEMAKER and FRAMEMAKER. The Examiner believes that said trademark/trade names were used in Claim 15 as limitations to identify or describe a particular material or product, specifically a commercial database and a commercial pagination program. The Examiner argues that trademark/trade names are used to identify the source of the goods, not the goods themselves. And thus, the Examiner believes the use of FILEMAKER and FRAMEMAKER in Claim 15, makes the claim indefinite and fails to comply with §112.

Applicant hereby cancels Claim 15 without prejudice to refiling it at a later date and without any admission that it is not patentable. The cancellation reduces the subject matter before the Examiner and, hopefully, expedites the process of reaching agreement on the language for the remaining claims.

3. 35 U.S.C. §102 Rejection

Claims 1, 5, 9-11 were rejected under 35 U.S.C. §102(e) as being anticipated by Makipaa (US 6,556,217). Anticipation is a factual determination. In order to establish anticipation, it is incumbent upon the Examiner to identify in a single prior art reference disclosure of each and every element of the claims in issue, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 U.S.P.Q. 481 (Fed. Cir. 1984); *In re Schaumann*, 572 F.2d 312, 197 U.S.P.Q. 5 (C.C.P.A. 1978) (anticipation is measured with respect to the terms of the claims in issue).

When determining if a prior art reference anticipates a claim containing elements expressed as a means for performing a function pursuant to 35 U.S.C. § 112, last paragraph, "the limitations which must be met are those set forth in each statement of function." *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1445 n.5, 221 U.S.P.Q. 385, 389 (Fed. Cir. 1984).

When the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, the reference does not anticipate. *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1480, 1 U.S.P.Q.2d 1241, 1245-46 (Fed. Cir. 1986), cert. denied, 482 U.S. 909, 107 S.Ct. 2490 (1987).

Applicant respectfully traverses the rejection of Claims 1, 5, 9-11. Without limitation, Makipaa discloses a method for resizing a display screen so that the display screen may be displayed on a "...user terminal having any size screen." It does not disclose each of the elements of Claim 1. Without limitation, the claim of "adding a field directive to said record, wherein said field directive contains an instruction to said pagination program directing how said pagination program will format said output" in Claim 1 is not found in Makipaa. The Examiner argues that col. 7, lines 5-7 is readable on this portion of Claim 1, however Makipaa describes a completely different process. Makipaa takes an existing "page"

and uses the “user and terminal profiles ... and the device translation table” (Makipaa col. 7, lines 5-6), to resize the content to be displayed. The information that Makipaa uses is not an added field, but rather is a set of characteristics that the terminal has to which the “page” must be resized. See (Makipaa col. 7, lines 55-61) Thus, a field directive is never added to any record in Makipaa. Additionally, the information in the “user and terminal profiles ... and the device translation table” is not used by Makipaa to direct a pagination program to direct how output will be formatted, rather it is used as information to determine the size of the terminal. Conversely, Applicant’s invention field directive that is added to a record that follows the record and directs later pagination. Makipaa makes no mention of aspects of Applicant’s invention and does not anticipate Claim 1.

Regarding Claim 5, please incorporate the same arguments as set forth above regarding Claim 1.

Regarding Claim 9, please incorporate the same arguments as set forth above regarding Claim 1. Additionally, Makipaa does not disclose using a first and second record for the same output. Because Makipaa is designed to resize web-pages, it works on a single page, and thus actually teaches away from Applicant’s invention that is designed to be able to take multiple records and paginate them for output.

Regarding Claim 10, please incorporate the same arguments as set forth above regarding Claim 9.

Regarding Claim 11, please incorporate the same arguments as set forth above regarding Claim 9.

Claim 12 was rejected under 35 U.S.C. §102(e) as being anticipated by Sutcliffe (US 6,253,216). Applicant respectfully traverses the rejection of Claims 1, 5, 9-11. Without limitation, Sutcliffe discloses a method for personalizing a stock web-page on a “personals” web-server. It does not disclose each of the elements of Claim 1. Without limitation, the claim of “controlling a computer system to create a file template” is not disclosed by Sutcliffe. While Sutcliffe does disclose using an existing template, the templates in Sutcliffe are preset. This is evidenced by the intent of the Sutcliffe disclosure, which is to make personalizing a web-page from an existing template. Applicant’s invention, as claimed in Claim 12, includes the creation of the file template. Additionally, Sutcliffe makes no mention of a pagination program.

Thus, neither patent cited by the Examiner discloses each and every element of the claims at issue.

4. 35 U.S.C. §103(a) Rejections

Pursuant to 35 U.S.C. §103(a), the Examiner has rejected Claims 2 and 6 on the basis that such claims obvious in light of Makipaa in view of Sutcliffe. Applicant notes that the written office action did not include any discussion of reason for Examiner's rejection of Claim 6, but that in a telephone conference with Applicant's attorney, the Examiner indicated Claim 6 was being rejected for the same reasons as Claim 2.

These references cannot be combined in that they are unrelated, and neither patent suggests the use of the other. All of the elements of Claim 2 as depending from Claim 1, and Claim 6 as depending from Claim 5, are not disclosed or suggested by the references. The first element Examiner discusses is the obtaining of the first recipient's address information. The second element also involves the first recipient, however in Sutcliffe, who the Examiner uses as the first recipient changes. Specifically, in Sutcliffe col. 4, lines 1-5, an operator takes identification information from a client who would like to place a personals advertisement, while in col. 10, lines 32-37, Sutcliffe describes giving a viewer permission to view the personal advertisement. Conversely, Applicant's invention provides cost containment in allowing the catalogue developer to weed out bad customers. The first recipient is the same "person" in Applicant's invention. Additionally, Sutcliffe describes a client giving permission to another person to view their advertisement, which does not suggest determining the status of the first recipient's account as claimed by Applicant. Additionally, none of the elements of the "characteristic" are disclosed or suggested by the references. Additionally, Sutcliffe uses the permission to allow viewing of the personals ad, while Applicant's invention uses the characteristic to stop the sending of a catalogue to a poor customer. Finally, in regard to Claim 6, Sutcliffe discloses an operator obtaining the identification and address information, not the computer program.

For these reasons, without limitation, the cited references are unrelated to Applicant's disclosure and claims. That is, Sutcliffe specifically teaches away from Applicant's invention. The functionality described in Sutcliffe is to provide a personalized "personals" web-page. In contrast, Applicant's invention is directed at creating product catalogues. As stated above, the references cannot be combined, because nothing in either patent suggests the use of the other. However, even if they are combined, in no way do they suggest or teach Applicant's invention.

CONCLUSION

In view of the above, it is submitted that the remaining claims are in a condition for allowance. Reconsideration and withdrawal of the rejections and objections are hereby requested. Allowance of Claims 1-14 and 16-20 at an early date is solicited.

If impediments to allowance of Claims 1-14 and 16-20 remain and a telephone conference between the undersigned and the examiner would help remove such impediments in the opinion of the examiner, a telephone conference is respectfully requested.

Respectfully submitted,

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